

The opinion in support of the decision being entered today  
was **not** written for publication in a law journal and  
is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JIANN H. CHEN, JOSEPH A. PAVLISKO,  
CHARLES C. ANDERSON and ROBERT A. LANCASTER

MAILED

JUL 27 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Appeal No. 2003-1989  
Application 09/608,818<sup>1</sup>

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ON BRIEF

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Before PAK, KIMLIN, and JEFFREY T. SMITH, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is remanded to the examiner for appropriate action  
consistent with the views expressed below.

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<sup>1</sup> Application for patent filed June 30, 2000.

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The Rule 196(d) order entered May 27, 2004 required the appellants to clarify their election of the options listed under 37 CFR § 1.196(b)(2002), which reads in relevant part:

When the Board of Patent appeals and Interferences makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two option with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner...

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record... (Emphasis added.)

Pursuant to our order entered May 27, 2004, the appellants elected to prosecute the application before the examiner under the provisions of 37 CFR §§ 1.196(b)(1) and 1.197(a). See the Request for Reconsideration by Examiner dated July 16, 2004, Paper No. 25, page 1. Specifically, the appellants requested "that this case be remanded to the Examiner for further action under the provisions of 37 CFR §§ 1.196(b)(1) and 1.197(a)." *Id.*

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The appellants then asked the examiner to reconsider the patentability of the claimed subject matter in light of the newly introduced Declaration executed by Jiann H. Chen, one of the inventors listed in this application, on April 14, 2004 ("Chen Declaration"). *Id.*


In accordance with the above election made by the appellants, we remand this application to the examiner for further action consistent with the provisions of 37 CFR §§ 1.196(b)(1) and 1.197(a). We advise the examiner to consider our suggestion at page 6 of the decision entered February 26, 2004, which directs the examiner to determine "whether Eddy alone or in combination with Blong affects the patentability of the claimed subject matter" in the event of further prosecution of this application.


This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D) (8th Ed., Rev. 1, Feb. 2003). It is important that the Board be informed promptly of any action affecting the appeal in this case.

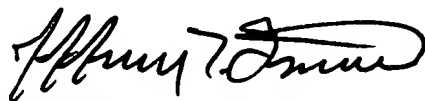
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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

REMANDED

  
EDWARD C. KIMLIN )  
Administrative Patent Judge )

  
CHUNG K. PAK )  
Administrative Patent Judge )

  
JEFFREY T. SMITH )  
Administrative Patent Judge )

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